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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,964	03/22/2002	Akihiro Goto	Q69055	4903

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WASHINGTON, DC 20037

EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,964

Applicant(s)

GOTO ET AL.

Examiner

Kishor Mayekar

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 13-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission in view of either JP 57061026 A or JP 63200465 A, for reasons as of record.
3. Claim 13 is under 35 U.S.C. 103(a) as being unpatentable over JP 57061026 A. JP '026 is directed to method of producing conductive plastic molding having excellent electroconductivity which comprises the steps of providing a powder of a hard material having an electrical insulating property; coating the powder with a coating containing an electrically conductive material; and compression-molding the coated powder to form a conductive plastic molding (see abstract). The difference between the reference and the above claim is the intended use of the molding. The subject matter as a whole would have been obvious to one having ordinary skill

in the art at the time the invention was made to have modified the reference's teachings because it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art and in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

4. Claim 13 is under 35 U.S.C. 103(a) as being unpatentable over JP 63200465
- A. JP '465's invention is directed to a method of producing silver oxide battery which comprises the steps of coating silver oxide with gold to form powder and compression-molding the coated powder to form an electrode (see abstract). The difference between the reference and the above claim is the intended use of the electrode. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings because it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the

claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art and in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

5. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission as modified by either JP '026 or JP '465 as applied to claim 13 above, and further in view of either Onishi et al. (5,718,736) or Sung (6,286,498). The difference between the references as applied above and the instant claims are the of heating the compact and the step of adding wax to the coated powder. Onishi shows the use of wax as molding auxiliary in a method of compressing molding powders (col. 8, lines 36-46). Sung shows the same in a method of forming a molded product (col. 10, lines 17-31). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as shown by either Onishi or Sung because it has been held the use of conventional materials to

perform their known functions in a conventional process is obvious". *In re Raner* 134 USPQ 343.

6. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either JP '026 or JP '465 as applied to claim 13 above, and further in view of either Onishi et al. (5,718,736) or Sung (6,286,498). The difference between the each of the references as applied above and the instant claims are the step of heating the compact and the step of adding wax to the coated powder. Onishi shows the use of wax as molding auxiliary in a method of compressing molding powders (col. 8, lines 36-46). Sung shows the same in a method of forming a molded product (col. 10, lines 17-31). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as shown by either Onishi or Sung because it has been held the use of conventional materials to perform their known functions in a conventional process is obvious". *In re Raner* 134 USPQ 343.

Response to Arguments

7. Applicant's arguments filed 14 December 2004 considered but they are not persuasive.

In response to applicant's argument that there is no motivation to combine Applicant's admission with either of the '026 or '450 JPs, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that either of the JP references represents non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, since the claim recites a method of making an electrode, an electroconductive molding, since both the JP references are directed to a method of making an electroconductive

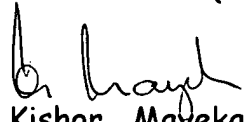
compact which comprises all the steps as claimed, and since there is no manipulative difference of the intended use in a process of making as compared to the prior art, both the JP reference are analogous art.

To the argument that none of the JP references teach, suggest or disclose the limitation that the electrically conductive coating acts as a binder during compression molding, since the claims recite the steps of coating the powder with an electroconductive material and compression-molding the coated powder and since both the JP references discloses the same two steps to form an electroconductive molding, it appears that that the recited steps and both JP references' steps are equivalent, hence the binder's acting limitation.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kishor Mayekar
Primary Examiner
Art Unit 1753